

Attorney Docket No: 21295-23

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#7
Election
Inclusion
1/3/02

Application No.: 09/826,712 ✓
Filed: April 5, 2001 ✓
Title: Double Confocal Scanning Microscope
Applicant(s): Johann Engelhardt, et al. ✓
Examiner: Nguyen, Thong Q.
Art Unit: 2872

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

CERTIFICATE OF FACSIMILE

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being sent by facsimile to Examiner Thong Nguyen at 703-308-7724 on the date shown below:

By:

Deborah Celeste

Date

FAX COPY RECEIVED

DEC 28 2001

TECHNOLOGY CENTER 2800

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the office action mailed November 28, 2001, Applicants elect group II, claims 10-18. Applicants respectfully traverse and wish to place the application in better condition to appeal the restriction requirement.

The Examiner has stated:

- "Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 4-6, drawn to a scanning microscope having a beam splitter of an interferometer for defining two optical paths, classified in class 356, subclass 450.

09/826,712

2

- II. Claims 10-18, drawn to a scanning microscope having a detecting system with specific features concerning the structure and its position with respect to other components of the scanning microscope, classified in class 250, subclass 491.1.

The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility for use in a microscope for splitting a light path into two individual light paths without the use of a detecting system with specific features concerning the position of the detecting system in a microscope, and the invention II has separate utility for use with a microscope having a detection system without the use of a beam splitter of an interferometer for splitting a light beam. See MPEP § 806.05(d)."

The forward to the MPEP states, in relevant part: "The Manual does not have the force of law or the force of the Patent Rules of Practice in Title 37, Code of Federal Regulations." What 35 U.S.C. 121, the law, states in relevant part is: "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Note that 37 C.F.R. §§ 1.141 and 1.142 also speak of "independent and distinct" inventions. The Examiner has only argued that the inventions are distinct. The Examiner has not also argued, as required by 35 U.S.C. 121, that the inventions are also independent. Therefore, the restriction requirement is improper and Applicants request that it be withdrawn.

Note that Applicants do not consider the explanation of the meaning of "independent" and "distinct" in MPEP § 802.01 persuasive.

The MPEP §802.01 Meaning of "Independent" and "Distinct":

"35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The

09/826,712

3

hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

09/826,712

4

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended."

The arguments presented in the MPEP seem to rest on two pillars:

- 1) Apparently, the novel statutory construction theory being put forward is that in the absence of legislative history on a given point, the law doesn't mean what the law says. Applicants submit that the statutory construction as described by the Supreme Court should be given deference: "[I]n interpreting a statute a court should always turn to one cardinal canon before all others. . . . [C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there." *Connecticut Nat'l Bank v. Germain*, 112 S. Ct. 1146, 1149 (1992). Certainly, "[w]hen the words of a statute are unambiguous, then, this first canon is also the last: 'judicial inquiry is complete.'" *Id.*
- 2) "Independent and distinct" has the same meaning as "distinct." This is a logical impossibility if "independent" and "distinct" have different definitions, yet MPEP § 802.01 concedes that that they do have different definitions and helpfully provides them.

Therefore, the applicants suggest that the Examiner has not satisfied 35 U.S.C 121 in the restriction requirement. If the Examiner wishes to maintain the restriction requirement, the applicants respectfully request that the Examiner also explain how the subject matter represents two "independent" inventions, according to the definition of "independent" given in MPEP § 802.01.

Claims 1-3, and 7-9.

Claims 1-18 are subject to the restriction requirement. Applicants traverse the restriction requirement for yet another reason: independent claim 1 is generic to the subcombinations as defined by the Examiner. No detailed action on independent claim 1 and dependent claims 2-3 and 7-9 is provided in the present Office Action. Applicants argue that the restriction requirement is improper and should be withdrawn, because the subcombinations, as defined by the Examiner, are generically claimed in independent claim 1 (MPEP 806.05(d) and MPEP 806.04(b)).

09/826,712

5

Withdrawal of the restriction requirement is hereby respectfully requested.

Respectfully submitted,

Maria Eliseeva

Dated: December 28, 2001

Maria Eliseeva (Reg. No. 43,328)
Brown, Rudnick, Freed, & Gesmer
One Financial Center
Boston, MA 02111
617-856-8340

Customer No. 21710

#1076635 v1 - 21295/23

FAX COPY RECEIVED

DEC 28 2001

TECHNOLOGY CENTER 2800

BR BROWN
FG RUDNICK
FREED &
GESMER

FAX COVER SHEET

DATE: DECEMBER 28, 2001

THIS TRANSMISSION CONSISTS OF THIS COVER SHEET AND

5

PAGE(S).

ORIGINAL DOCUMENT TO FOLLOW:

YES ☐NO ☒

FAX NUMBER: 1-703-308-7724

ATTENTION OF: Examiner Thong Q. Nguyen

TELEPHONE NUMBER:

FROM: Maria M. Eliseeva DIRECT DIAL: (617) 856-8340

OUR FAX NUMBER IS: (617) 856-8201

C/M/A #: MME/21295/23/2335

MESSAGE:

Serial No.: 09/826,712
Group No: 2872

FAX COPY RECEIVED

DEC 28 2001

TECHNOLOGY CENTER 2800

If you do not receive all pages, please call (617) 856-8200 and ask for Office Services.

*****CONFIDENTIALITY NOTE*****

The documents accompanying this fax transmission contain information from the law firm of Brown, Rudnick, Freed & Gesmer which is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution or use of the contents of this faxed information is prohibited. If you have received this fax in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.

A PARTNERSHIP OF PROFESSIONAL CORPORATIONS

One Financial Center
Boston, MA 02111
Tel: (617) 856-8200
Fax: (617) 856-8201

One Providence Washington
Plaza
Providence, RI 02903
Tel: (401) 276-2600
Fax: (401) 276-2601

CityPlace I
165 Asylum Street
Hartford, CT 06103-3402
Tel: (860) 509-6500
Fax: (860) 509-6501

8 Clifford Street
London W1S 2LQ
United Kingdom
Tel: 011-44-20-7851-6000
Fax: 011-44-20-7851-6100

JEK